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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/039,591	10/24/2001	Pablo Munoz JR.	B-0103.29	2215

7590 05/03/2004

LAW OFFICES OF CHRISTOPHER I. MAKAY  
1634 Milam Building  
115 East Travis Street  
San Antonio, TX 78205

EXAMINER

MRUK, BRIAN P

ART UNIT PAPER NUMBER

1751

DATE MAILED: 05/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/039,591	<b>Applicant(s)</b> MUNOZ ET AL.	
	<b>Examiner</b> Brian P Mruk	<b>Art Unit</b> 1751	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 31 March 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 59-71 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 59-71 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>12-11-01</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Election/Restrictions*

1. Applicant's election without traverse of Group IV, claims 59-71 in the Paper dated March 31, 2004 is acknowledged. The examiner also acknowledges that non-elected claims 1-58 have been cancelled without prejudice.
2. Claims 67-68 and 70-71 are objected to because of the following informalities:  
Instant claims 67-68 and 70-71 are objected to for containing improper Markush language. Specifically, the phrase "may be selected from" in instant claims 67-68 and 70-71 should be amended to recite, "are selected from" to contain proper Markush language. **See MPEP 2173.05(h)**. Appropriate correction is required.

### *Claim Rejections - 35 USC § 112*

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:  

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claims 61 and 62-71 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
5. The phrase "up to about" in claims 61, 62 and 64 renders the claims vague and indefinite. The phrase "up to about" renders the claims indefinite, since one of ordinary

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skill in the art would not be able to ascertain the metes and bounds of the phrase "up to about". It is unclear what values are encompassed by the phrase "up to about". The examiner suggests that this phrase should be changed to either "up to". "Claims reciting "up to about" are invalid for indefiniteness where there was close prior art and there was nothing in the specification, prosecution history, or the prior art to provide any indication as to what range of specific activity is covered by the term about." **See MPEP 2173.05(b)**. Appropriate correction and/or clarification is required.

6. Instant claims 63 and 65-71 are rejected under 35 U.S.C. 112, second paragraph, for being dependent upon a claim with the above addressed 112 problem.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 59-71 are rejected under 35 U.S.C. 102(b) as being anticipated by Onan et al, U.S. Patent No. 5,968,879.

Onan et al, U.S. Patent No. 5,968,879, discloses a polymeric composition comprising water, a water-soluble monomer, an initiator, and an oxygen scavenger (see col. 2, lines 25-42). It is further taught by Onan et al that the water includes fresh water,

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seawater, brine, or water containing various salts (see col. 3, lines 25-30), and that the composition may also contain i) an oxygen scavenger, such as hydrochloric acid (see col. 4, lines 40-49), ii) a gelling agent, such as cellulose derivatives and guar gum (see col. 4, lines 50-65), iii) a foaming agent, such as an ammonium alcohol ether sulfate (see col. 5, lines 25-50), and iv) a foam stabilizing agent, such as methoxypolyethylene glycol (see col. 6, lines 29-67). Specifically, note Example Nos. 8-10 in Table II, which were made by adding hydroxyethylcellulose, a sulfated linear alcohol ethoxylate, methoxypolyethylene glycol, silica, hydrochloric acid, and hydroxyethylacrylate to a solution of synthetic seawater, per the requirements of instant claims 59-71. Therefore, instant claims 59-71 are anticipated by Onan et al, U.S. Patent No. 5,968,879.

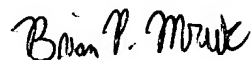
9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Mruk whose telephone number is (571) 272-1321. The examiner can normally be reached on Monday-Thursday from 7:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta, can be reached on (571) 272-1316. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.



Brian Mruk  
April 29, 2004



Brian P. Mruk  
Primary Examiner  
Tech Center 1700